

ESTTA Tracking number: **ESTTA602141**

Filing date: **05/02/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91215266
Party	Plaintiff Premier Systems USA, Inc.
Correspondence Address	GREGORY B PHILLIPS KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET, 14TH FLOOR IRVINE, CA 92614 UNITED STATES efiling@knobbe.com
Submission	Other Motions/Papers
Filer's Name	Gregory B. Phillips
Filer's e-mail	efiling@knobbe.com
Signature	/gregory phillips/
Date	05/02/2014
Attachments	Opposer's Opposition to Motion to Dismiss.pdf(423190 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

PREMIER SYSTEMS USA, INC.
a California corporation,
Opposer,

V.

GRIFFIN TECHNOLOGY, INC.
 a Tennessee corporation,
 Applicant.

) Opposition No.: 91215266
)
) Mark: OLLI
) Serial No.: 85/939,010
)
)
)
)
)
)
)
)

OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO DISMISS

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Pursuant to 37 C.F.R. § 2.127(a) and TBMP § 503, Opposer Premier Systems USA, Inc. (“Opposer”) hereby opposes the Motion to Dismiss (“Motion”) filed on April 14, 2014, by Applicant Griffin Technology, Inc. (“Applicant”) in Opposition No. 91215266. Opposer respectfully submits that the claims set forth in the Notice of Opposition against Application No. 85/939,010 (“Applicant’s Application”) are legally sufficient. Accordingly, Applicant’s Motion should be denied, and Applicant should be ordered to answer the Notice of Opposition without further delay.

I. INTRODUCTION

Opposer filed its Notice of Opposition in this proceeding on March 4, 2014. In lieu of filing an Answer to Opposer's Notice of Opposition, Applicant has moved to dismiss the Notice of Opposition for failure to state a claim upon which relief can be granted pursuant to Federal Rule of Civil Procedure 12(b)(6). However, Applicant's Motion is baseless. Opposer's claims

in its Notice of Opposition are legally sufficient. Opposer alleges facts that establish that it has standing to maintain the Opposition and that valid grounds exist for denying Applicant's Application based on a likelihood of confusion with Opposer's marks.

Contrary to Applicant's allegations in its Motion, facts establishing the DuPont factors do not need to be alleged in a Notice of Opposition because they are matters for proof and not pleading. Whether Opposer can prove its allegation of a likelihood of confusion is not a matter to be determined on a motion to dismiss. While Applicant's motion is titled a "Motion to Dismiss," it is instead an improper motion for summary judgment that seeks to introduce evidence on matters outside the pleadings. Applicant's Motion is inappropriate at this stage of the proceedings.

II. APPLICANT'S MOTION SHOULD BE DENIED

A. Legal Standard

"A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of the complaint." T.B.M.P. § 503.02. "To survive a motion to dismiss, a complaint must contain sufficient factual matter, accepted as true, to 'state a claim to relief that is plausible on its face.'" Ashcroft v. Iqbal, 556 U.S. 662, 678, 129 S. Ct. 1937, 1949 (2009). Specifically, in the context of an opposition "to withstand a motion to dismiss, petitioner need only allege such facts which, if proved, would establish that petitioner is entitled to the relief sought; that is, (1) petitioner has standing to bring the proceeding, and (2) a valid statutory ground exists for [denying] the registration." Corporacion Habanos, S.A. v. Rodriguez, 99 U.S.P.Q.2d 1873, 1874 (T.T.A.B. 2011); T.B.M.P. § 503.02.

In addressing a motion to dismiss for failure to state a claim upon which relief can be granted, all of the plaintiff's well-pleaded allegations must be accepted as true, and the complaint

must be construed in the light most favorable to the plaintiff. Corporacion Habanos, 99 U.S.P.Q.2d at 1874. Moreover, the pleading must be examined in its entirety, “construing the allegations therein liberally,” to determine whether it contains any allegations that, if proved, would entitle plaintiff to the relief sought. Meckatzer Lowenbrau Benedikt Weiß KG v. White Gold, LLC, 95 U.S.P.Q.2d 1185, 1187 (T.T.A.B. 2010) (quoting Fair Indigo LLC v. Style Conscience, 85 U.S.P.Q.2d 1536, 1538 (T.T.A.B. 2007)).

The elements of a claim need only be stated simply, concisely, and directly and include only “enough detail to give the defendant fair notice of the basis for each claim.” T.B.M.P. § 309.03(a)(2). More importantly, Opposer need not submit proof in support of its claims in the Notice of Opposition. T.B.M.P. § 503.02 (“Whether a plaintiff can actually prove its allegations is a matter to be determined not upon motion to dismiss, but rather at a final hearing or upon summary judgment, after the parties have had an opportunity to submit evidence in support of their respective positions.”).

B. Opposer’s Claims Set Forth in its Notice of Opposition are Legally Sufficient

A Notice of Opposition is legally sufficient if it sets forth a short and plain statement showing why Opposer believes it would be damaged by registration of a mark and states one or more valid grounds for opposing the application. T.B.M.P. § 309.03(a)(2).¹ Available grounds for an opposition include that the applicant’s mark so resembles a mark or trade name previously used in the United States by another, so as to be likely to cause confusion, mistake or deceive under Trademark Act Section 2(d), 15 U.S.C. § 1052(d). T.B.M.P. § 309.03(c). There are two elements to a claim of likelihood of confusion under Section 2(d) of the Trademark Act: priority and likelihood of confusion. See Baseball Am., Inc. v. Powerplay Sports Ltd., 71 U.S.P.Q.2d

¹ This Opposition to the Motion to Dismiss does not discuss in detail the sufficiency of Opposer’s allegations relating to standing as Applicant does not appear to challenge these allegations.

1844, 1848 (T.T.A.B. 2004) (identifying priority and likelihood of confusion as the two elements of a Section 2(d) ground for opposition).

Opposer sufficiently alleges the two elements required for a claim of likelihood of confusion. The Notice of Opposition recites the specific dates of filing and first use for each of Opposer's trademark registrations and applications relied upon as the basis for the Opposition. Notice of Opposition ¶¶ 2, 3, and 5-7. Further, the Notice of Opposition alleges the filing date and filing basis of Applicant's Application, and based on these facts, Opposer asserts "Opposer's rights in its OLLOCLIP and OLLO marks are prior and superior to any rights Applicant may claim to the alleged mark OLLI." *Id.* ¶ 10. Thus, Opposer alleges with legal sufficiency that it has priority, the first element of a likelihood of confusion claim.

Moreover, Opposer's Notice of Opposition sets forth plausible facts in support of a likelihood of confusion, the second element of a claim under Section 2(d) of the Trademark Act. Specifically, Opposer alleges "[b]y virtue of Opposer's continuous and substantial use, the OLLOCLIP and OLLO marks have become identifiers of Opposer and its goods and distinguish Opposer's goods from the goods and services of others." Notice of Opposition ¶ 8. Further, Opposer asserts that the "goods listed in Applicant's OLLI Application are related to Opposer's goods sold in connection with Opposer's OLLOCLIP and OLLO marks" and "the alleged mark OLLI so resembles Opposer's OLLOCLIP and OLLO marks." *Id.* ¶¶ 11 & 12. Opposer alleges that it "will be damaged by registration of Applicant's alleged mark OLLI subject of Applicant's OLLI Application, in that the alleged mark OLLI so resembles Opposer's OLLOCLIP and OLLO marks registered and applied for in the PTO, and in which Opposer owns common law trademark rights, as to be likely, when used on or in connection with the goods identified in

Applicant's OLLI Application, as to cause confusion, or to cause mistake or to deceive within the meaning of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d)." *Id.* ¶ 12.

Contrary to Applicant's assertions in its Motion, Opposer need not submit proof relating to the DuPont factors in its Notice of Opposition; nor does Opposer need to respond to Applicant's Motion by submitting proof relating to its claims and specifically the DuPont factors. T.B.M.P. § 503.02 ("[A] plaintiff served with a motion to dismiss for failure to state a claim upon which relief can be granted need not, and should not respond by submitting proofs in support of its complaint."). Accordingly, Opposer has properly pled its claim for likelihood of confusion.

C. Applicant Attempts to Disguise its Improper Motion for Summary Judgment and Judgment on the Pleadings as a Motion to Dismiss.

Applicant's Motion sets forth a litany of factors that are matters for proof, not facts that must be pleaded with a Notice of Opposition. Specifically, Applicant's Motion recites the thirteen DuPont factors used by the Board to determine whether there is a likelihood of confusion, and Applicant then argues without any basis or support that Opposer is required to submit proof relating to each of the relevant DuPont factors in order to sufficiently plead its claims. Contrary to Applicant's assertion, under the law, Opposer is not required to set forth proof relating to the DuPont factors in its Notice of Opposition. *See Compagnie Gervais Danone v. Precision Formulations, LLC*, 89 U.S.P.Q.2d 1251, 1256 (T.T.A.B. 2009) (the Board noted the difference between facts such as the filing date, filing basis, publication date and applicant's name in an application that are not subject to proof, and allegations relative to acquired distinctiveness that are not objective facts and are subject to proof). In fact, "[e]videntiary matters ... should not be pleaded in a complaint. They are matters for proof, not for pleading." T.B.M.P. § 309.03(a)(2). Moreover, Opposer went above and beyond what is required to

sufficiently plead its claim, and as discussed above, Opposer alleges plausible facts in support of the “two key considerations” in determining a likelihood of confusion: the similarity of the marks and the goods. In re Thor Tech, Inc., 90 U.S.P.Q.2d 1634, 1635 (T.T.A.B. 2009).

Although Applicant’s motion is titled “Motion to Dismiss,” it is merely an improper attempt for summary judgment and judgment on the pleadings on the issue of likelihood of confusion. Because a party cannot file a motion for summary judgment until it has made initial disclosures, a motion for summary judgment is completely improper at this stage of the proceedings. T.B.M.P. §§ 503.04 & 528.02; see also Qualcomm Inc. v. FLO Corp., 93 U.S.P.Q.2d 1768, 1770 (T.T.A.B. 2010) (denying a motion for summary judgment as premature where the moving party had not served its initial disclosures). Applicant spends the vast majority of its Motion arguing that Opposer has failed to prove a likelihood of confusion. Applicant’s contentions that Opposer has failed to establish a likelihood of confusion is completely inappropriate at this stage of the proceedings.

Further, Applicant’s Motion seeks an improper judgment on the pleadings. For example, Applicant makes statements such as “[f]rom the face of the Opposition, it is clear that Griffin’s OLLI mark is spelled and pronounced differently from Premier’s alleged OLLOCLIP and OLLO marks” and “the face of the Opposition belies any allegation that the OLLI mark will be used on similar goods as the OLLOCLIP and OLLO marks.” Applicant’s attempt for judgment on the pleadings at this stage is also completely inappropriate. T.B.M.P. § 504.01 (“a motion for judgment on the pleadings must be filed after the pleadings are closed”). Because Applicant is unable to identify any insufficiencies in Opposer’s Notice of Opposition, Applicant instead improperly makes arguments relating to matters of proof that may theoretically be

appropriate matters for a motion for summary judgment or motion for judgment on the pleadings, but not a motion to dismiss.

D. Applicant Submits Improper Evidence Outside of the Pleadings

Applicant improperly attempts to submit evidence that is outside the pleadings. Healthcalc.net, Inc. v. Healthcare Quality Insights, Inc., 2003 WL 22080501, at *1 (T.T.A.B. Sep. 4, 2003) (“inasmuch as a motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of a complaint and not the sufficiency of the evidence that may be adduced, matters outside of the pleadings are not considered”); see also Compagnie Gervais Danone, 89 U.S.P.Q.2d at 1256 (“if a motion to dismiss is filed that references matters outside the pleadings, the Board may exclude from consideration the matters outside the pleadings and may consider the motion for whatever merits it may present as a motion to dismiss”). Specifically, in support of its Motion, Applicant submits printouts from the Trademark Electronic Search System showing third-party pending applications and registrations, the Global Glossary, and Opposer’s website. Applicant submits the printout from the Trademark Electronic Search System in an attempt to show that other third-party marks contain the letters “OLL,” which is evidence outside of what was plead in the Notice of Opposition. Furthermore, Applicant submits printouts from the Global Glossary and Opposer’s website to allege that the word “ollo” means “eye” in the Galician language. The alleged meaning of the term “OLLO” is also evidence outside of the matters pled in the Notice of Opposition. Accordingly, such evidence should not be considered by the Board in reviewing Opposer’s Motion because it relates to matters outside of the pleadings. Healthcalc.net, Inc., 2003 WL 22080501, at *1 (refusing to consider the moving party’s exhibits in support of its Motion to Dismiss as they were matters outside the pleadings).

Moreover, Applicant's request that the Board take judicial notice of "the fact that the word 'ollo' means 'eye' in the Galician language" is improper. In support of this request, Applicant cites the printouts it improperly submitted from the Global Glossary and Opposer's website. This request for judicial notice is improper for at least two reasons. First, the fact for which Applicant requests judicial notice relates to matters outside the pleadings and should not be considered on a motion to dismiss. James River Petroleum Inc. v. Petro Stopping Centers L.P., 50 U.S.P.Q.2d 1702, 1703 (T.T.A.B. 1999) (denying request for judicial notice in a motion to dismiss because it was viewed as an improper motion for summary judgment). Second, this fact does not constitute matter of which the Board may take judicial notice. T.B.M.P § 704.12(a) ("The only kind of fact that may be judicially noticed by the Board is a fact that is 'not subject to reasonable dispute in that it is either (1) generally known within the territorial jurisdiction of the trial court or (2) capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned.'"); see also UMG Recordings, Inc. v. Mattel, Inc., 100 U.S.P.Q.2d 1868, 1874 (T.T.A.B. 2011) (the Board refused to take judicial notice of web pages from websites); In re Total Quality Group, Inc., 51 U.S.P.Q.2d 1474, 1475 (T.T.A.B. 1999) (the Board refused to take judicial notice of on-line dictionaries which do not otherwise exist in print format.). Accordingly, Applicant's request for judicial notice should be denied.

/ / /

/ / /

/ / /


III. CONCLUSION

For the reasons above, Opposer respectfully requests that the Board deny the Motion to Dismiss and Applicant's request for judicial notice. In the event that the Board does grant the Motion, however, Opposer requests time to amend its Notice of Opposition pursuant to T.B.M.P. § 503.03.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: May 2, 2014

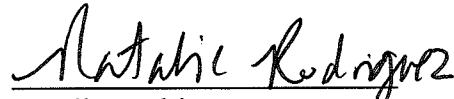
By: 
Steven J. Nataupsky
Gregory B. Phillips
Nicole Townes
2040 Main Street, Fourteenth Floor
Irvine, CA 92614
(949) 760-0404
efiling@knobbe.com
Attorneys for Opposer,
PREMIER SYSTEMS USA, INC.

CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **OPPOSER'S OPPOSITION TO APPLICANT'S MOTION TO DISMISS** upon Applicant's counsel of record by depositing a copy thereof in the United States Mail, first-class postage prepaid on May 2, 2014, addressed as follows:

Terry L. Clark
BASS, BERRY & SIMS PLC
1201 Pennsylvania Avenue NW, Suite 300
Washington, DC 20004

Robert L. Brewer
Martha B. Allard
BASS, BERRY & SIMS PLC
150 Third Avenue South, Suite 2800
Nashville, TN 37201


Natalie Rodriguez

17813123